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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,764	10/07/1999	SUZANNE M. PAULEY	460.1791USU	3820

7590

01/12/2004

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EXAMINER

KIDWELL, MICHELE M

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 01/12/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/414,764

Applicant(s)

PAULEY ET AL.

Examiner

Michele Kidwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 is/are allowed.
- 6) ☐ Claim(s) 1-3, 5, 7-11, 13, 14, 16-19 is/are rejected.
- 7) ☒ Claim(s) 12, 20 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

This application contains claims 4 and 6 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 3, 5, 8 – 11, 14 and 16 – 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Matthews (4335721).

Matthews discloses a tampon (with a coverstock) that is made from a mixture of absorbent and non-absorbent fibers as claimed. Matthews discloses the claimed type of fibers in the claimed ratio. See column 2, lines 19-56. With respect to the limitation of "wherein immediately after complete ejection in the applicator" the examiner does not feel that this limitation claims anything not found in the prior art. The prior art is fully capable of being compressed and placed in an applicator and after ejection will expand as claimed. The amount of expansion clearly depends on the diameter prior to ejection and this depends on the size (diameter) of the applicator itself, so the prior art is

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inherently capable of being compressed by 25%, placed in an applicator and then expelled and allowed to return to its original dimensions. The prior art is fully capable of performing the recited function.

Claims 1, 9 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Lloyd et al. (5374258).

Lloyd discloses a tampon with a coverstock that is made up of absorbent and non-absorbent fibers as claimed. See column 2, lines 51-57. With respect to the limitation of "wherein immediately after complete ejection in the applicator" the examiner does not feel that this limitation claims anything not found in the prior art. The prior art is fully capable of being compressed and placed in an applicator and after ejection will expand as claimed. The amount of expansion clearly depends on the diameter prior to ejection and this depends on the size of the applicator itself, so the prior art is capable of being compressed by 25%, placed in an applicator and then expelled and allowed to return to its original dimensions. The prior art is fully capable of performing the recited function.

Claims 1 – 3, 5, 7 – 11, 13 – 14, 16 and 18 – 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Foley et al. (5817707).

Foley discloses a tampon that is made with absorbent and non-absorbent fibers as claimed. Foley discloses the claimed type and claimed ratio of fibers. The tampon has a coverstock. See column 5, lines 36-60. Foley discloses the claimed denier for the

fibers. With respect to the limitation of "wherein immediately after complete ejection in the applicator" the examiner does not feel that this limitation claims anything not found in the prior art. The prior art is fully capable of being compressed and placed in an applicator and after ejection will expand as claimed. The amount of expansion clearly depends on the diameter prior to ejection and this depends on the size of the applicator itself, so the prior art is capable of being compressed by 25%, placed in an applicator and then expelled and allowed to return to its original dimensions. The prior art is fully capable of performing the recited function.

Claims 1 – 3, 5, 8 – 11, 16 and 18 – 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Olofsson et al. (3986511).

Olofsson discloses a tampon that is made from a mixture of absorbent and non-absorbent fibers as claimed. See column 3, lines 8-44. Olofsson discloses the claimed type and ratio of fibers. With respect to the limitation of "wherein immediately after complete ejection in the applicator" the examiner does not feel that this limitation claims anything not found in the prior art. The prior art is fully capable of being compressed and placed in an applicator and after ejection will expand as claimed. The amount of expansion clearly depends on the diameter prior to ejection and this depends on the size of the applicator itself, so the prior art is capable of being compressed by 25%, placed in an applicator and then expelled and allowed to return to its original dimensions. The prior art is inherently fully capable of what is claimed.

Allowable Subject Matter

Claims 12 and 20 – 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 22 is allowed.

Response to Arguments

Applicant's arguments filed September 8, 2003 have been fully considered but they are not persuasive.

With respect to the Matthews reference applicant has argued that Matthews does not disclose a blended tampon with the claimed types of fibers. Applicant is referred to column 2, lines 19-56, especially lines 42-47 where it is disclosed that the tampon may be made up of 30-60% fusible fibers (non-absorbent) and the remaining fibers are cellulosic in nature (absorbent). Both types of fibers are present in the tampon so this is a blend as far as the examiner is concerned. Applicant seems to argue that parallel arrangement of fibers cannot be a blend. Why not?

The only other argument presented concerns the limitation of how much expansion occurs after complete ejection of the tampon. Applicant has argued that this limitation is not inherent in the applied 102 references because the examiner has no factual evidence to support the fact that it is inherent. The examiner respectfully disagrees.

The amount of expansion after complete expulsion directly depends on how much compression there is prior to ejection. That would depend on the diameter of the applicator itself. One could take the same tampon and eject it from two differing diameter applicators and come up with two different percentages of expansion, even though the tampon is the same structurally. This further points to the fact that the expansion is directly dependent on how much the tampon was compressed in the applicator. There is nothing structurally claimed in the pending claims that is not found in the prior art, other than the functional language which is dependent on the applicator and is not something that is always present with the claimed tampon. The 102 references do not specifically state that the tampon can be compressed by 2%, 50 does that mean that it must be factually proven by the examiner (who has not testing facilities of any kind to even test the expansion of the prior art) that the tampons of the 102 references will or can be compressed by 2%? The references do not state that the tampons could be inserted with a paper applicator. Again, does the examiner need to factually prove that a paper applicator can be used? Another way to look at this issue is that the claimed limitation of the expansion is directed to the intended use of the device (i.e. depends on how much it is compressed in the applicator, and this depends on the diameter of the applicator chosen). If one were to put the tampon in an applicator, where the tampon is only compressed to 10%, how does applicant achieve the 25% expansion claimed? In this example there would not be a 25% expansion, only 10% because the expansion is dependent on the diameter of the applicator it is put into. The examiner considers the prior art to satisfy the limitation that has been argued.

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Additionally, the claim scope allows for the tampon to contact water after ejection and to have its expansion attributed to that. Applicant is relying upon an intended use functional recitation for patentability of an article, the arguments of which are found to be non-persuasive.

The declaration under 37 CFR 1.132 filed September 8, 2003 is insufficient to overcome the rejection of claims 1 – 3, 5, 7 – 11, 13 – 14, and 16 – 19 based upon specific references applied under 35 U.S.C. 102 as set forth in the last Office action because: the declaration presents a number of commercially available tampons that have been tested and in which it has been determined that each commercially available tampon pledget that has been tested does not experience dry expansion immediately after expulsion from the tampon applicator.

The examiner finds the declaration non persuasive because the facts presented are not germane to the rejection at issue. The present issue is whether or not the tampons provided by the prior art are capable of performing the recited function. The tampons provided by the prior art references utilize materials that are identical in nature and in ratio to that of the claimed invention. As noted by the applicant's specification on page 4, line 23 to page 5, line 5, the nature of the fibers and the ratio in which the fibers are present allows for the pledget to expand immediately upon ejection from the tampon applicator.

The declaration provided by the applicant does not disclose the nature and/or ratio of fibers present in any of the commercially available tampon pledgets that have

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been tested, so the statement that none of the commercially available tampon pledgets tested is irrelevant since the applicant (1) has not provided the composition of these pledgets and (2) and has not addressed the prior art references that teach the same composition and ratio of fibers as the claimed invention.

Further, the applicant is again reminded that the claim scope allows for the tampon to contact water after ejection and to have its expansion attributed to that. Applicant is relying upon an intended use functional recitation for patentability of an article, the arguments of which are found to be non-persuasive

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 703-305-2941. The examiner can normally be reached on Monday - Friday, 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703-308-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Michele Kidwell
Michele Kidwell
January 10, 2004

014
GLENN K. DAWSON
PRIMARY EXAMINER